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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,354	07/03/2001	Ulrich Abel	112740-235	1058

29177 7590 12/27/2004

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EXAMINER

WONG, BLANCHE

ART UNIT PAPER NUMBER

2667

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/898,354

Applicant(s)

ABEL ET AL.

Examiner

Blanche Wong

Art Unit

2667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6 and 7 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date Jul3'01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Nutzdaten in Fig. 2. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claim 4 is objected to because of the following informalities: -- information -- is missing between -- user -- and -- and signaling information -- similarly recited in cl. 3, ln. 3. Cl. 4, ln. 3 would read "user information and signaling information" in consistent with wording in other claims. Appropriate correction is required.
3. Claim 6 is objected to because of the following informalities: extra words -- user data -- in -- second user data connection -- in ln. 3. Cl. 6, ln. 3 would read "second

connection" in consistent with wording in other claims. Appropriate correction is required.

4. Claim 9 is objected to because of the following informalities: missing "link" between – first – and – and second connection – in ln. 2-3. Cl. 9, ln. 2-3 would read "first link and second connection" in consistent with wording in other claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1,6,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan et al. (U.S. Pat No. 6,453,034) in view of Berg et al. (U.S. Pat No. 6,680,952).

With regard to claims 1 and 7, Donovan discloses two enterprise gateways (first and second conversion devices, as recited in cl. 7) in which there are a signaling and media gateways separating signaling and voice (user information) transmission. Fig. 3. Media gateway 59 provides protocol translation (converting the user information) between traditional telephony time division multiplexed voice circuits to an IP transport protocol. Col. 3, ln. 14-16. However, Donovan discloses the signaling gateway 57 also provides protocol translation col. 3, ln. 6 and fails to explicitly show "joining the user information to the signaling information," as recited in claim 1.

In an analogous art, Berg discloses two PBXs 100,160 in Fig. 1 (a first and second communication device, as recited in cl. 7), and a media gateway controller that handle signaling traffic col. 4, ln. 40. The signaling data is transmitting over a backhaul signaling link 140 (first link) to the media gateway controller 120, and this backhaul signaling link 140 can be an IP connection and therefore signaling bits are packaged in IP packets. Col. 5, ln. 66-Col. 6, ln. 9. Berg further discloses that protocol conversion is not required col. 6, ln. 55 and that terminating gateway 150 receiving signaling from media gateway controller 120 and voice through packet-switching network 130 to complete voice telecommunication col. 6, ln. 36-50.

A person of ordinary skill in the art would have been motivated to employ Berg in Donovan in order to obtain untempered signaling and converted data transmission in separate signaling and data transmission. The suggestion/motivation to do so would have been to provide for a scalable telecommunications network. Col. 2, ln. 20-21. At the time the invention was made, therefore, it would have been obvious to one of ordinary skill in the art to which the invention pertains to combine Berg and Donovan to obtain the invention as specified in claim 1.

With regard to claim 6, Donovan further discloses H.323. Col. 3, ln. 14.

***Allowable Subject Matter***

7. Claims 2-5,8,9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blanche Wong whose telephone number is 571-272-3177. The examiner can normally be reached on Monday through Friday, 830am to 530pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BW  
December 21, 2004



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